provided that when A^8 is not a lipophilic D-amino acid or is not deleted then at least one of A^6, A^7, A^9, A^{10}, A^{11} and A^{12} is a D-amino acid or at least one of A^6, A^7, A^9, A^{10}, A^{11}, A^{12}, A^{13}, A^{14}, A^{15}, A^{16}, A^{17}, A^{18}, A^{19}, A^{20}, A^{21} and A^{22} is deleted.

REMARKS

Reconsideration of the Office Action mailed August 28, 1998, (hereinafter "instant Office Action"), entry of the amendments hereinabove, withdrawal of the objection to claims 12, 15, 19, 22, 26, 29, 34, 37, 42 and 45, and withdrawal of the rejection of claims 1-11, 13, 14, 16-18, 20, 21, 23-25, 27-28, 30-33, 35, 36, 38-41, 43, 44, 46 and 47, are respectfully requested.

Applicants file herewith an Information Disclosure Statement with a list of citations on Form PTOL-A820 along with the references cited therein and an authorization to charge Applicants Deposit Account 50-0590 for the fee due under 37 C.F.R. 1.17(p).

In the instant Office Action, claims 1-47 are listed as pending, claims 12, 15, 19, 22, 26, 29, 34, 37, 42 and 45 are listed as objected to, claims 1-11, 13, 14, 16-18, 20, 21, 23-25, 27-28, 30-33, 35, 36, 38-41, 43, 44, 46 and 47, are listed as rejected.

Applicants address each of the issues the Examiner has raised according to the Examiner's paragraph numbers.

1. The Examiner has rejected claims 7-11, 13, 14, 16-18, 20, 21, 23-25, 27, 28, 30-33, 35, 36, 38-41, 43 and 44 under 35 U.S.C. §112, second paragraph, for the reasons stated at page 2

of the instant Office Action. Applicants have made the changes to the claims in accordance with the Examiner's recommendations. With particular regard to the inadvertent omission of "deleted" from the definition of "A^{13}" in claim 10, Applicants intended the definition to include "deleted" and the proviso clause in claim 10 supports Applicants' intention. The absence of "deleted" from the definition of A^{13} in claim 10 was an inadvertent omission and it is believed that the correction thereof does not add new matter. With particular regard to the definition of "X" in claims 13 and 14, it is clear that the omission of said definition was an inadvertent error. Applicants consistently used the moiety "X-Phe" throughout all of the other claims having a formula; and defined "X" to be "X for each occurrence is independently selected from the group consisting of OH, a halo and CH_3" in the other claims having a definition of "X". Therefore, the omission of the definition of "X" from claims 13 and 14 is clearly an inadvertent error and it is believed that the correction thereof does not to add new matter.

5. The Examiner has rejected claims 1-3, 7, 9 and 13 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-23 of U.S. Patent No. 5,723,577. Applicants respectfully traverse this rejection. The general rule in considering an obviousness-type double patenting rejection is that:

> [i]n considering the question of obvious variation, the patent disclosure may not be used as prior art. . . .

> This is not meant to infer that the disclosure may not be used at all. It may, for instance, be used as a dictionary to learn the meaning of the terms of the claim. It would not be appropriate, however, to indiscriminately use all the generalities of the disclosure. It is only that which is related to and supportive of the claim of the invention that may be used to determine the scope of the claim.

Phillips Petroleum Co. v. U.S. Steel Corp., 673 F. Supp. 1278, 6 USPQ2d 1065, 1090 (D. Del. 1987), *aff'd*, 865 F.2d 1247, 9 USPQ2d 1461 (Fed. Cir. 1989). Thus, only the claims of the instant application can be compared with the claims of the '577 patent cited against the instant application. In the case of a provisional obviousness-type double patenting rejection, the claims of the instant application can be compared only with the claims of the co-pending application cited against the claims of the instant application.

Applicants point out that claim 1 of the instant application and its dependent claims define the compounds claimed not only by structure, that is "PTH analogue or a truncated PTH analogue" but also by functional language, namely the PTH analogues or a truncated PTH analogue "selectively bind to the PTH2 receptor". This functional limitation of the claims of the instant application is an element which defines the metes and bounds of the compounds being claimed just as much as a chemical structure defines a compound of the instant invention. Applicants have taught how to synthesize the compounds of the instant application and how to test the compounds of the instant application for binding activity to the PTH2 receptor. Thus, a compound of the

instant application has to be synthesized and have tested positive for selective binding to the PTH2 receptor for the compound to fall within the claims of the instant application.

Therefore, in addition to the structural elements, the prior art patent or application must teach or suggest the functional limitation of selectively binding to the PTH2 receptor in its claims.

Applicants direct the Examiner's attention to page 2, line 21 to page 3, line 9, of the instant application which explains the difference between a compound that binds to the PTH2 receptor and a compound that selectively binds to the PTH2 receptor. Non-selective PTH2 binding compounds are known in the art, see the discussion at page 3, lines 1-3. However, selective PTH2 binding compounds are to the best of Applicants' knowledge not known in the prior art.

More particularly, turning to the Examiner's allegation that the peptides of the '577 patent would inherently selectively bind to the PTH2 receptor because of the similarity between the peptides of the instant application and the peptides of the '577 patent, this aspect of the rejection appears to be based in the doctrine of inherency. The doctrine of inherency applies when something must occur as a necessary result of the disclosed prior art process. Applicants note that the compounds of the '577 patent are noted to bind to the PTH/PTHrP (PTH1) receptor. Although binding to the PTH1 receptor does result in some level

of binding to the PTH2 receptor, it does not result in selective binding to the PTH2 receptor versus the PTH1 receptor. Therefore, it is not an inherent property of all or even most compounds that bind to the PTH1 receptor that it would preferably bind to the PTH2 receptor. Or in other words, binding to the PTH1 receptor does not necessarily result in the selective binding to the PTH2 receptor. Therefore, mere similarity of structure is not a basis for assuming that a PTH1 receptor binding compound would selectively bind to the PTH2 receptor.

The claims of the '577 patent do not suggest that the PTH/PTHrP analogues disclosed therein bind selectively to the PTH2 receptor. Since the claims of the '577 patent (as well as the specification) do not suggest compounds having selective PTH2 binding activity, the obviousness-type double patenting rejection cannot be maintained.

Further, for those instances where claims 1-3, 7, 9 and/or 13 of the instant application may encompass compound(s) of the '577 patent which have inherent selective PTH2 binding activity, said claims of the instant application can be considered to claim species of the genus of compounds of the '577 patent; the species being those compounds of the '577 patent that have selective PTH2 binding activity. That is, Applicants have discovered a surprising unexpected activity among a sub-genus of PTH analogues and PTHrP analogues, namely that the sub-genus selectively binds to the PTH2 receptor.

Applicants point out that:

> [i]t is well settled that a valid patent may issue for a nonobvious improvement on a prior patented invention, even though the improvement falls within the claims of that prior patent.[5] This suggests that a prior genus which does not explicitly disclose a species does not anticipate a later claim to that species.[5]...Corning Glass Works v. Sumitomo Electric U.S.A., 868 F.2d 1251, 1262, 9 USPQ2d 1962, 1970 (Fed. Cir. 1989)

Donald S. Chisum, Patents, A Treatise on the Law of Patentability, Validity and Infringement, Vol. 1, 3-21, 1992. Therefore, the possibility that claims 1-3, 7, 9 and/or 13 could encompass a compound of the '577 patent does not support a rejection under obviousness-type double patenting since a species patent can co-exist with a genus patent.

Accordingly, the obviousness-type double patenting rejection of claims 1-3, 7, 9 and 13 over U.S. Patent No. 5,723,577 should be withdrawn.

6. The Examiner has rejected claims 1-3, 7, 9, 10 and 13 under the judicially created doctrine of obviousness-type double patenting. Applicants incorporate herein Applicants' argument under paragraph 5. More particularly, the claims of the '062 patent do not suggest that the compounds claimed therein possess selective PTH2 binding activity. With particular regard to claim 10, Applicants point out that the '062 patent requires that the side chain residues of its "A_{13} and A_{17}, A_{26} and A_{30} or A_{13} and A_{17} and A_{26} and A_{30}" are linked by a disulfide bond or an amide bond, see column 25, lines 14-16. This limitation is not in Applicants'

claims and, therefore, the '062 patent does not anticipate any of the rejected claims. Accordingly, the rejection of claims 1-3, 7, 9, 10 and 13 under the judicially created doctrine of obviousness-type double patenting over the '062 patent, should be withdrawn.

7. The Examiner has provisionally rejected claims 1-3, 7, 9 and 13 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1 and 32 of copending application No. 08/779,768. Applicants respectfully traverse this rejection. Applicants incorporate herein Applicants' argument of paragraph 5, hereinabove. More particularly, the claims of the '768 application do not suggest that the compounds claimed therein selectively bind to PTH2. Further, Applicants note that the compounds of the '768 application preferentially bind to the PTH1 receptor. Accordingly, the provisional rejection of claims 1-3, 7, 9 and 13 under obviousness-type double patenting over the '768 application, should be withdrawn.

8. The Examiner has provisionally rejected claims 1-3, 7, 9 and 13 under the judicially created doctrine of obviousness-type double patenting over copending application No. 08/813,534. Applicants respectfully traverse this rejection. Applicants incorporate herein Applicants' argument of paragraph 5, hereinabove. More particularly, the claims of the '534 application do not suggest that the compounds claimed therein

selectively bind to PTH2. Further, Applicants note that the compounds of the '534 application preferentially bind to the PTH1 receptor. Accordingly, the provisional rejection of claims 1-3, 7, 9 and 13 under obviousness-type double patenting over the '534 application, should be withdrawn.

10. The Examiner has rejected claims 1-3, 7, 9 and 13 under 35 U.S.C. 102(f) and/or (g) as allegedly being anticipated by U.S. Patent No. 5,723,577. Applicants respectfully traverse this rejection. Applicants incorporate herein Applicants' argument of paragraph 5, hereinabove. More particularly in reply to the anticipation rejection, Applicants direct the Examiner's attention to the Court of Appeals for the Federal Circuit's (CAFC) ruling on the standard for anticipation under 35 U.S.C. §102(b): "[i]t is elementary that an anticipation rejection requires a showing that each limitation of a claim must be found in a single reference, practice or device", In re Donohue, 226 U.S.P.Q. 619, 621 (CAFC 1985); and "...exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference." Atlas Power Co. v. E. I. duPont DeNemours & Co., 224 U.S.P.Q. 409, 411 (CAFC 1984). Applicants note that the '577 patent does not disclose or teach an element of the claims of the instant application, namely that the compounds of the '577 patent selectively bind to the PTH2 receptor. The absence of this element from the teachings and disclosure of the '577 patent means that the '577 patent does not

disclose each element of the rejected claims of the instant application.

With regard to the issue of inherency, in addition to the foregoing arguments in paragraph 5, Applicants note that compounds that bind to the PTH1 receptor will not selectively bind to the PTH2 receptor. It may be that there may be some non-exemplified compounds of the '577 patent that will selectively bind to the PTH2 receptor. However, all of the exemplified compounds of the '577 selectively bind to the PTH/PTHrP (PTH1) receptor thereby excluding the possibility that they would selectively bind to the PTH2 receptor. Thus, the property of selectively binding to the PTH2 receptor is not an inherent property of all or even a majority of the compounds of the '577 patent; selective binding to the PTH1 receptor precludes selective binding to the PTH2 receptor.

Applicants reiterate that the relationship between the compounds of the instant application that overlap with the compounds of the '577 patent is more appropriately characterized as being that of one between species and genus. In such a relationship, it is well accepted that the prior genus does not anticipate the later species.

Based upon the foregoing, the rejection of claims 1-3, 7, 9 and 13 under 35 U.S.C. §102(f) and/or (g) should be withdrawn.

11. The Examiner has rejected claims 1-9, 13, 16, 20, 23, 27, 30, 31, 35, 38, 39, 43, 46 and 47 under 35 U.S.C. 102(e) as

allegedly being anticipated by U.S. Patent 5,723,577. Applicants respectfully traverse this rejection. Applicants incorporate herein Applicants' arguments under paragraphs 5 and 10, hereinabove. The arguments point out that the '577 patent does not anticipate: the compounds of claims 1-9 and 13; the methods of claims 16, 20, 30, 31, 35, 38, 39, 43, 46 and 47; and the pharmaceutical compositions of claims 23 and 27, since said claims encompass a compound that selectively binds to the PTH2 receptor. This limitation is not taught or disclosed in the '577 patent.

Based upon the foregoing, the rejection of claims 1-9, 13, 16, 20, 23, 27, 30, 31, 35, 38, 39, 43, 46 and 47 under 35 U.S.C. 102(e) over U.S. Patent 5,723,577, should be withdrawn.

12. The Examiner has rejected claims 1-3, 7, 9, 10 and 13 under 35 U.S.C. §102(f) and/or (g) as allegedly being anticipated by U.S. Patent No. 5,717,062. Applicants respectfully traverse this rejection. Applicants incorporate herein Applicants' arguments of paragraphs 5, 6 and 10, hereinabove. Accordingly, the rejection of claims 1-3, 7, 9, 10 and 13 under 35 U.S.C. 102(f) and/or (g) over the '062 patent, should be withdrawn.

13. The Examiner has rejected claims 1-10, 13, 16, 17, 20, 23, 24, 27, 30-32, 35, 38-40, 43, 46 and 47, under 35 U.S.C. §102(e) over U.S. Patent 5,717,062. Applicants incorporate herein Applicants' arguments of paragraphs 5, 6 and 10, hereinabove. Applicants have argued that mere similarity of structure by

itself does not support an assumption that the compounds are obviously the same as the compounds of the '0562 patent. Accordingly, the rejection of claims 1-10, 13, 16, 17, 20, 23, 24, 27, 30-32, 35, 38-40, 43, 46 and 47, under 35 U.S.C. §102(e) over U.S. Patent No. 5,717,062, should be withdrawn.

14. The Examiner has rejected claims 1-3, 7, 9 and 13 under 35 U.S.C. §102(f) and/or (g) as allegedly being anticipated by copending Application No. 08/779,768. Applicants respectfully traverse this rejection. Applicants incorporate herein Applicants' arguments of paragraphs 5 and 10, hereinabove. More particularly, Applicants reiterate that the relationship between the compounds of the instant application that overlap with the compounds of the '768 application is more appropriately characterized as being that of a species and genus relationship. In such a relationship, it is well accepted that the prior genus does not anticipate the later species. Accordingly, the rejection of claims 1-3, 7, 9 and 13 under 35 U.S.C. 102(f) and/or (g) over the '768 application, should be withdrawn.

15. The Examiner has rejected claims 1-9, 13, 16, 20, 23, 27, 30, 31, 35, 38, 39, 43, 46 and 47, under 35 U.S.C. §102(e) over copending Application No. 08/779,768. Applicants incorporate herein Applicants' arguments of paragraphs 5 and 10, hereinabove. Applicants have demonstrated that the mere similarity of structure by itself is a sufficient basis to assume that the compounds would bind selectively to the PTH2 receptor. Further,

not all elements of the rejected claims of the instant application are taught or disclosed by the '768 application. Accordingly, the rejection of claims 1-9, 13, 16, 20, 23, 27, 30, 31, 35, 38, 39, 43, 46 and 47, under 35 U.S.C. §102(e) over Application No. 08/779,768, should be withdrawn.

16. The Examiner has rejected claims 1-3, 7, 9 and 13 under 35 U.S.C. §102(f) and/or (g) as allegedly being anticipated by copending Application No. 08/813,534. Applicants respectfully traverse this rejection. Applicants incorporate herein the arguments of paragraphs 5 and 10, hereinabove. More particularly, Applicants reiterate that not all elements of the instant application are disclosed by the '768 application. Accordingly, the rejection of claims 1-3, 7, 9 and 13 under 35 U.S.C. 102(f) and/or (g) over Application No. 08/813,534, should be withdrawn.

17. The Examiner has rejected claims 1-9, 13, 16, 20, 23, 27, 30, 31, 35, 38, 39, 43, 46 and 47, under 35 U.S.C. §102(e) over copending Application No. 08/813,534. Applicants respectfully traverse this rejection. Applicants incorporate herein the arguments of paragraphs 5 and 10, hereinabove. Applicants have argued that the similarity of structure by itself is not a sufficient basis for assuming that a compound of the '534 application would selectively bind to the PTH2 receptor. Further, not all elements of the rejected claims of the instant application are disclosed or taught by the '534 application. Accordingly, the rejection of claims 1-9, 13, 16, 20, 23, 27, 30,

31, 35, 38, 39, 43, 46 and 47, under 35 U.S.C. §102(e) over Application No. 08/813,534, should be withdrawn.

18. The Examiner has rejected claims 1-3, 7, 9, 10, 23 and 24 under 35 U.S.C. §102(b) over Holick. Applicants respectfully traverse this rejection. Applicants incorporate herein Applicants' arguments of paragraphs 5 and 10, hereinabove. With particular regard to claims 1-3, 7, 9, 23 and 24, Applicants point out that Holick does not teach or disclose that its compounds selectively bind to the PTH2 receptor. Further, Applicants have argued that it cannot be assumed that structural similarity alone is predictive of whether a compound will selectively bind to the PTH2 receptor.

With particular regard to claim 10 over Holick, Applicants point out that the proviso clause at the end of claim 10 of the instant application effectively excludes the species that the Examiner has cited from Holick. Therefore, there is no overlap between Holick and the compounds of claim 10 of the instant application.

Based upon the foregoing, the rejection of claims 1-3, 7, 9, 10, 23 and 24 under 35 U.S.C. §102(b) over Holick should be withdrawn.

19. The Examiner has rejected claims 1-9, 16, 23, 30, 31, 38, 39, 46 and 47 under 35 U.S.C. §102(b) over Willick et al. Applicants respectfully traverse this rejection. Applicants incorporate herein Applicants' arguments of paragraphs 5 and 10,

hereinabove. Applicants point out that Willick et al. do not teach or disclose that its compounds selectively bind to the PTH2 receptor. Further, Applicants' have argued that it cannot be assumed that structural similarity alone is predictive of whether a compound will selectively bind to the PTH2 receptor.

Based upon the foregoing, the rejection of claims 1-9, 16, 23, 30, 31, 38, 39, 46 and 47 under 35 U.S.C. §102(b) over Willick et al., should be withdrawn.

20. The Examiner has rejected claims 1-9, 16, 23, 30, 31, 38, 39, 46 and 47 under 35 U.S.C. §102(e) over Duvos et al. Applicants respectfully traverse this rejection. Applicants incorporate herein Applicants' arguments of paragraphs 5 and 10, hereinabove. More particularly, Duvos et al. do not teach or disclose that its compounds selectively bind to the PTH2 receptor. Applicants have shown that inherency is not applicable since compounds that bind to the PTH1 receptor selectively do not selectively bind to the PTH2 receptor.

Accordingly, the rejection of claims 1-9, 16, 23, 30, 31, 38, 39, 46 and 47 under 35 U.S.C. §102(e) over Duvos et al., should be withdrawn.

21. The Examiner has rejected claims 1-6, 46 and 47 under 35 U.S.C. §102(e) over Duvos et al. Applicants respectfully traverse this rejection. Applicants incorporate herein Applicants' arguments of paragraphs 5 and 10, hereinabove. Applicants note that claim 1 is directed to a "PTH analogue", thus, by definition

the word analogue does not include the native sequence of hPTH(1-34). Accordingly, the rejection of claims 1-6, 46 and 47 under 35 U.S.C. §102(e) over Duvos et al. is obviated and should be withdrawn.

22. The Examiner has rejected claims 1-3, 7, 9 and 10 under 35 U.S.C. §102(b) over the Neugebauer article. Applicants respectfully traverse this rejection. Applicants incorporate herein Applicants' arguments under paragraphs 5 and 10, hereinabove. More particularly, Applicants note that the Neugebauer article does not teach that its compounds selectively bind to PTH2. Further, selective PTH2 binding is not an inherent property of all or even most PTH1 binding compounds. With particular regard to claim 10 of the instant application, Applicants note that the proviso clause at the end of claim 10 effectively excludes the compounds disclosed by Neugebauer.

Accordingly, the rejection of claims 1-3, 7, 9 and 10 under 35 U.S.C. §102(b) over the Neugebauer article should be withdrawn.

23. The Examiner has rejected claims 1-8, 13, 14, 20, 21, 27, 28, 30, 35, 36, 38, 43, 44, 46 and 47 under 35 U.S.C. §102(b) over Chorev et al., '779. Applicants respectfully traverse this rejection. Applicants incorporate herein the arguments of paragraphs 5 and 10, hereinabove. More particularly, the '779 patent does not disclose that the compounds disclosed therein selectively bind to the PTH2 receptor. With regard to the

Examiner's inherency argument, Applicants have noted that structural similarity alone is not an indicator of a compound's ability to selectively bind to the PTH2 receptor. With particular regard to claim 14 of the instant application, Applicants point out that the '779 patent discloses compounds that are bonded by Lys^{13} and Asp^{17}. The compounds of claim 14 of the instant application are not bonded at the A^{13} and A^{17} positions. Therefore, there is no overlap between the compounds of the '779 patent and claim 14 of the instant application.

Based upon the foregoing, the rejection of claims 1-8, 13, 14, 20, 21, 27, 28, 30, 35, 36, 38, 43, 44, 46 and 47 under 35 U.S.C. §102(b) over Chorev et al., '779, should be withdrawn.

24. The Examiner has rejected claims 1-10, 16, 17, 23, 24, 30-32, 38-40, 46 and 47 under 35 U.S.C. §102(b) over Nakagawa et al. Applicants respectfully traverse this rejection. Applicants incorporate herein Applicants' arguments of paragraphs 5 and 10, hereinabove. With particular regard to claim 10, Applicants note that the proviso clause at the end of claim 10 effectively excludes the compounds of Nakagawa et al. Therefore, there is no overlap between Nakagawa et al. and claim 10 of the instant application. Accordingly, the rejection of claims 1-10, 16, 17, 23, 24, 30-32, 38-40, 46 and 47 under 35 U.S.C. §102(b) over Nakagawa et al., should be withdrawn.

25. The Examiner has rejected claims 1-10, 13, 16, 17, 20, 23, 24, 27, 30-32, 35, 38-40, 43, 46 and 47 under 35 U.S.C. §102(b)

over WO application '193. Applicants respectfully traverse this rejection. Applicants incorporate herein Applicants' arguments of paragraphs 5, 6 and 10, hereinabove. More particularly, Applicants note that WO application '193 is the PCT counterpart of U.S. Patent No. 5,717,062 cited in paragraph 6 of the instant Office Action, thus, the same arguments submitted under paragraph 6, hereinabove is applicable to this rejection. Accordingly, the rejection of claims 1-10, 13, 16, 17, 20, 23, 24, 27, 30-32, 35, 38-40, 43, 46 and 47 under 35 U.S.C. §102(b) over WO application '193, should be withdrawn.

26. The Examiner has rejected claims 1-3, 7, 9, 10, 13 and 14 under 35 U.S.C. §102(b) over the Chorev et al. article. Applicants respectfully traverse this rejection. Applicants incorporate herein Applicants' arguments of paragraphs 5 and 10, hereinabove. More particularly, Applicants point out that the Chorev et al. article does not disclose or teach that the compounds will selectively bind to the PTH2 receptor.

With particular regard to claims 10 and 14, Applicants point out the following, first, the proviso clause at the end of claims 10 and 14 effectively exclude all of the compounds of the Chorev et al. article and secondly, A^{12} of claims 10 and 14 cannot be a D- or L-Ala, a D- or L-Trp, D- or L-α-Nal, or D- or L-β-Nal. Therefore, there is no overlap between the Chorev et al. article and the compounds of claims 10 and 14 of the instant application.

Based upon the foregoing, the rejection of claims 1-3, 7, 9, 10, 13 and 14 under 35 U.S.C. §102(b) over the Chorev et al. article, should be withdrawn.

27. The Examiner has rejected claims 4-6, 8, 16, 17, 20, 21, 23, 24, 27, 28, 30-32, 35, 36, 38-40, 43, 44, 46 and 47 under 35 U.S.C. §103(a) over the Chorev et al. article. Applicants respectfully traverse this rejection. Applicants incorporate herein the arguments of paragraphs 5 and 10, hereinabove. More particularly, Applicants point out that the Chorev et al. article does not disclose, teach or even suggest that the compounds can selectively bind to the PTH2 receptor. Further, the compounds disclosed by the Chorev et al. article are not the same as the compounds encompassed in the instant application. The Chorev et al. article does not teach or suggest how to test a compound for selective PTH2 receptor binding activity. Therefore, there is no motivation to select a compound of the instant application much less incorporate the compound into a pharmaceutical composition or use the compound according to Applicants' claims.

Based upon the foregoing, the rejection of claims 4-6, 8, 16, 17, 20, 21, 23, 24, 27, 28, 30-32, 35, 36, 38-40, 43, 44, 46 and 47 under 35 U.S.C. §103(a) over the Chorev et al. article should be withdrawn.

28. The Examiner has rejected claims 1-10, 16, 17, 23, 24, 30-32, 38-40, 46 and 47 under 35 U.S.C. §102(b) over Rosenblatt et al., '223. Applicants respectfully traverse this rejection.

Applicants incorporate herein Applicants' arguments of claims 5 and 10, hereinabove. More particularly, with regard to claim 10, Applicants note that the compound "[D-Phe^{7}, Tyr^{34}]hPTH(7-34)NH_2" is not encompassed by claim 10 since the proviso clause at the end of claim 10 excludes the Rosenblatt compound.

Based upon the foregoing, the rejection of claims 1-10, 16, 17, 23, 24, 30-32, 38-40, 46 and 47 under 35 U.S.C. §102(b) over Rosenblatt et al., '223, should be withdrawn.

29. The Examiner has objected to claims 12, 15, 19, 22, 26, 29, 34, 37, 42 and 45 as being dependent upon a rejected base claim and notes that these claims would be allowable if rewritten in independent form. Applicants note with appreciation the Examiner's position with regard to these claims, however, Applicants believe that all of the claims pending after entry of the amendments hereinabove are in condition for allowance. Therefore, Applicants choose not to amend these claims at this time pending the outcome of the prosecution of the rejected claims.

Accordingly, Applicants believe that the objection to claims 12, 15, 19, 22, 26, 29, 34, 37, 42 and 45, for being dependent on rejected base claims, should be withdrawn.

No fee is due for the amendments entered hereinabove as the number of claims remaining after entry of the amendment is the same as the number of claims which Applicants have already paid for.

Based upon the foregoing, Applicants believe that claims 1-47 are in condition for allowance. Prompt and favorable action is earnestly solicited.

Respectfully submitted,

Date: March 1, 1999

John D. Conway
Attorney for Applicants
Reg. No. 39,150

Biomeasure Inc.
27 Maple Street
Milford, MA 01757-3650
(508) 478-0144